

REMARKS

Applicants have cancelled claims 7-8 during prosecution of this patent application. Applicants are not conceding in this patent application that the subject matter encompassed by said cancelled claims are not patentable over the art cited by the Examiner, since the claim cancellations are only for facilitating expeditious prosecution of this patent application. Applicants respectfully reserve the right to pursue the subject matter encompassed by said cancelled claims, and to pursue other claims, in one or more continuations and/or divisional patent applications.

The Examiner withdrew newly submitted claims 9-12 on grounds of election by original presentation.

In a telephonic interview on May 4, 2009 between Examiner Maria Thein and Applicant's Representative Jack P. Friedman, the election of claims 9-12 by original presentation was discussed. It was agreed that arguments would be presented in the present office action response in traverse of the election of claims 9-12 by original presentation .

The Examiner rejected claims 1-3 and 5-6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over World Publication No. WO 96/13814 to Vazvan in view of U.S. Patent Application Publication No. 2003/0119478 to Nagy et al.

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over World Publication No. WO 96/13814 to Vazvan and U.S. Patent Application Publication No. 2003/0119478 to Nagy et al. as applied to claim 1 above, and further in view of U.S. Patent Application Publication No. 2003/0187795 to Lee et al.

Applicants respectfully traverse the withdrawal of claims 9-12 and the § 103 rejections with the following arguments.

Withdrawal of Claims 9-12

The Examiner withdrew newly submitted claims 9-12 on grounds of election by original presentation.

The Examiner argues: “Newly submitted claims 9-12 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims have separate utility such as a first user telephone number and a second user telephone number; said transaction server verifying that the second user telephone number matches the first user telephone number; a fee required to be paid by the user to the retailer with respect to the transaction; a second user identification identifying the user and the retailer had confirmed that the second user identification matched the first user identification... Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-12 are withdrawn from consideration.”

In response, Applicants respectfully contend that independent claim 9 could have been substantially obtained by amending claim 1 to add clarifying language and additional limitations to claim 1. Since it is normal and customary practice to amend claims in a manner that adds limitations to claims, an amendment of claim 1 to add the extra limitations in claim 9 would be proper and not withdrawable on grounds of election by original presentation. Therefore, claim 9, which is substantially similar to such an amended claim 1, is properly presented and should not have been withdrawn.

Next, Applicants explain the relationship between features of claim 9 specifically identified by the Examiner and corresponding features of claims 1-6.

The Examiner identified in claim 9 the feature of: a first user telephone number and a second user telephone number; said transaction server verifying that the second user telephone number matches the first user telephone number. Applicants respectfully note that the first telephone number of claim 9 corresponds to the “user wireless device phone number” stored in the transaction server of claim 1 (see preamble of claim 1); and the second telephone number of claim 9 corresponds to the “phone number of the wireless device communicated by the carrier transporting the SMS” recited in the “reading” step of claim 1.

The Examiner identified in claim 9 the feature of: said transaction server verifying that the second user telephone number matches the first user telephone number. Applicants respectfully note that the preceding “verifying” step in claim 9 corresponds to the step of “authenticating said phone number” in claim 1 in combination with “the authenticating said phone number step further comprising ... only if the phone number is identified as belonging to user information on the transaction server” in further combination with “a transaction server storing ... a wireless device phone number” in the preamble of claim 1.

The Examiner identified in claim 9 the feature of: a fee required to be paid by the user to the retailer with respect to the transaction. Applicants note that in claim 9, the retailer payment information comprises the fee. Applicants note that claim 1 recites “the payment information” but does not recite what the payment information comprises. Therefore, claim 9 recites limitations on the payment information not similarly recited in claim 1.

The Examiner identified in claim 9 the feature of: a second user identification identifying the user and the retailer had confirmed that the second user identification matched the first user identification. Applicants respectfully note that the second user identification in claim 9

corresponds to the user identification string in claim 3, and the first user identification in claim 9 corresponds to the user code stored in the transaction server of claim 1 (see preamble of claim 1). Applicants also note that the step in claim 9 of the retailer confirming that the second user identification matches the first user identification corresponds to the step in claim 3 of “authenticating the user identification string with the user confidential information received from the transaction server”.

Accordingly, Applicants request that claims 9-12 be examined.

35 U.S.C. § 103(a): Claims 1-3 and 5-6

The Examiner rejected claims 1-3 and 5-6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over World Publication No. WO 96/13814 to Vazvan in view of U.S. Patent Application Publication No. 2003/0119478 to Nagy et al.

Claims 1-3

A first example of why claim 1 is not unpatentable over Vazvan in view of Nagy is that Vazvan in view of Nagy does not teach or suggest the feature: “reading at the transaction server the phone number of the wireless device communicated by the carrier transporting the SMS”.

The Examiner argues: “Vazvan discloses ... Reading at the transaction sever the number of the phone number of the phone number of the wireless device communicated by the carrier transporting the SMS (page 5, lines 1-4; computing station can identify the calling party (payer) because it has received the calling party's identify from the wireless network)”.

In response, Applicants agree with the Examiner that Vazvan, page 5, lines 1-4 discloses that the computing station can identify the calling party (payer) because it has received the calling party's identify from the wireless network. However, Vazvan, page 5, lines 1-4 does not disclose that the computing station receives the phone number of the wireless device communicated by the carrier transporting the SMS. Applicants note that Vazvan, page 3, lines 25-28 discloses that the wireless network uses the phone number of the calling party's wireless device to identify the calling party, and the wireless network sends the calling party's identity to the transaction server (see Vazvan, page 3, lines 13-16). However, Vazvan does not anywhere disclose that the

wireless network communicates the phone number of the wireless device to the transaction server.

In "Response to Argument", the Examiner argues: "Vazvan teaches the disclosure above. Vazvan discloses a computing station which can identify the calling party because it has received the calling party's identify form the wireless network and compared with the calling party's identify based in the computing station (page 5, lines 1-5). Further, Vazvan teaches the computing station can identify the calling party. This needs that the user information should be confirmed by his/her telephone operator or service provider in a wireless communication network. User identity can be sent by user's telephone operator or service provider to the computing station when portable terminal set-ups a call or a short message to the computing station. Monitoring a calling party's subscriber number at a receiving terminal is a feature provided by today's digital telephone systems. (Page 3, lines 11-20) ... Such computing station which can identify the calling party because it has received the calling party's identify form the wireless network and compared with the calling party's identify based in the computing station; user identity which can be sent by user's telephone operator or service provider to the computing station when portable terminal set-ups a call or a short message to the computing station monitoring a calling party's subscriber number at a receiving terminal is a feature provided by today's digital telephone systems are considered "reading at the transaction server the phone number of the wireless device communicated by the carrier transporting the SMS"."

In response, Applicants note that the Examiner is arguing that a subscriber number in Vazvan is a phone number which is incorrect, because Vazvan, page 3, lines 18-32 explains that a subscriber number is a user identity that is included in a SIM card ("Monitoring a calling party's

subscriber number or information at a receiving terminal is a feature provided by today's digital telephone systems... Therefore, in this invention the computing station 2 receives at least the confirmed *user identity* from the user's telephone operator or service provider of a wireless communications network (WCN) 4 in order to identify who is in charge for payment of bills sent by portable terminal 1... In today's mobile telecommunications systems the *user identity, included in his/her SIM card*, is checked and confirmed by network 4 every time his/her portable terminal 1 is turned on and attached to the telephone network 4.”) (emphasis added).

Applicants next provide evidence demonstrating that the user identity included in a SIM card is identified with the user and not with a phone and is therefore not a phone number.

See “http://en.wikipedia.org/wiki/Subscriber_Identity_Module” which recites: “A **Subscriber Identity Module (SIM)** on a removable **SIM Card** securely stores the service-subscriber key (IMSI) used to identify a subscriber on mobile telephony devices (such as computers and mobile phones). The SIM card allows users to change phones by simply removing the SIM card from one mobile phone and inserting it into another mobile phone or broadband telephony device.”

The preceding quote proves that the user identity in the SIM card is not associated with a phone and is therefore not a phone number, which is also stated in U.S. Patent 6,141,563 (issued 10/31/2000), col. 1, lines 20-40 (“In a typical cellular telephone communication system, each subscriber unit is assigned a mobile subscriber identification (MSI) which uniquely identifies the subscriber unit from other subscriber units... In the present telecommunications environment, SIM cards are used to allow the SIM card holder to have access to any telecommunications device such as a cellular telephone which will receive the SIM card. The SIM card is used

primarily to provide a customer profile from which the customer may be billed for usage of the telecommunications network. Thus, the SIM card is used to authenticate or authorize a user. ”).

In summary, the claimed “phone number” is recited in claim 1 to be a “user wireless device phone number” and is thus associated with the wireless device. In contrast, the “subscriber number” in Vazvan is associated with the subscriber or user and not with a device. Thus, Vazvan does not disclose “reading at the transaction server the phone number of the wireless device communicated by the carrier transporting the SMS”.

Therefore, Vazvan does not disclose the preceding feature of claim 1.

A second example of why claim 1 is not unpatentable over Vazvan in view of Nagy is that Vazvan in view of Nagy does not teach or suggest the feature: “authenticating said phone number and retailer identification with the stored confidential user information” in combination with “a transaction server storing confidential user information including a retailer identification, a user code and a user wireless device phone number”.

The Examiner argues: “Vazvan discloses ... authenticating the phone number and retailer identification with the stored user information (page 15, lines 1-10)”.

In “Response to Argument”, the Examiner argues: “Vazvan teaches a mobile user who wants to pay a bill from an account to other, wherein he/she enters all information required for payment, such as his/her account number, the payee's account number, payment's due date, bill's reference number etc, to the mobile payment part of his/her portable terminal. Vazvan teaches the computing station can identify the calling party... The computing station checks the calling party's account and account number of payee (the account to which the payment should be

transferee) and then transfers the required amount of payment from the payer's account to the account of the payee. (Page 4, lines 16-32)".

In response, Applicants respectfully contend that the preceding arguments by the Examiner has not provided any evidence that the computing station in Vazvan (which represents the claimed transaction server) stores a user wireless device phone number. Therefore, Vazvan does not disclose authenticating the user wireless device phone number with a stored user wireless device phone number.

In further response, Applicants respectfully contend that the Examiner has not provided any evidence that the computing station in Vazvan stores a retailer identification. Although Vazvan discloses checking the account number of the payee (which represents the retailer identification), Vazvan does not disclose how checking the account number of the payee is performed and does not disclose that the computing station stores the account number of the payee. Accordingly, Vazvan does not disclose that checking the account number of the payee is performed by authenticating the account number of the payee with a stored account number of the payee.

Therefore, Vazvan does not disclose the preceding feature of claim 1.

A third example of why claim 1 is not unpatentable over Vazvan in view of Nagy is that Vazvan in view of Nagy does not teach or suggest the feature: "sending the user confidential information to the retailer POS" in combination with "a transaction server storing confidential user information including a retailer identification, a user code and a user wireless device phone number".

The Examiner argues that user confidential information is sent to Vazvan's computing station. The Examiner alleges that Vazvan's computing station is the retailer POS.

In response, Applicants note, from Vazvan, FIG. 1, that the computing station 2 is in the bank 3 and not in the retailer POS, since Vazvan's retailer POS in FIG. 1 is a restaurant which is physically separated from the computing station 2 by a PSTN/ISDN 7. Thus, sending information to the computing station 2 does not constitute sending the information to the retailer POS (i.e., to the restaurant).

Therefore, Vazvan does not disclose the preceding feature of claim 1.

A fourth example of why claim 1 is not unpatentable over Vazvan in view of Nagy is that Vazvan in view of Nagy does not teach or suggest the feature: "the user entering on the POS the user code and the POS reading and authenticating the user code with the user confidential information received from the transaction server".

The Examiner argues that Nagy discloses the preceding feature of claim 1 and further argues: "Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and computer program of Vazvan, to include POS and the user entering on the POS the user code and POS reading and authenticating the user code and executing the step if the user code is identified as belonging to the user confidential information as taught by Nagy in order to provide authenticate the subscriber to the financial network (Nagy, paragraph 35)."

In response, Applicants respectfully contend that the preceding reason offered by the Examiner for modifying Vazvan by the alleged teaching of Nagy is not persuasive. Applicants

respectfully contend that Vazvan teaches away from being modified by the alleged teaching of Nagy and incorporation of the alleged teaching of Nagy into Vazvan would destroy the primary motivation for Vazvan's invention.

See Vazvan, page 2, lines 18-24 ("The most important advantage gained by the inventive system is that all mobile telephone subscribers can pay their bills by using only their normal mobile telephones (in which the mobile payment part is included) and their subscriber identity or codes, without requiring any additional data modem, personal computer, and credit cards, etc. In this invention the subscriber identity and codes function as the credit card or bank card of the portable terminal's user.").

See Vazvan, page 3, lines 13-33 ("As it is the object of this invention, the user's own account information dose not need to be entered into the mobile payment part if the computing station, based in the bank 3, can identify the calling party. This needs that the user information (identity) should be confirmed by his/her telephone operator or service provider in a wireless communications network 4 and then be sent to the bank as a confirmation of user (subscriber) identification. More precisely, user identity can be sent by user's telephone operator or service provider to the computing station 2 when portable terminal 1 set-ups a call or short message to the computing station 2.... Therefore, in this invention the computing station 2 receives at least the confirmed user identity from the user's telephone operator or service provider of a wireless communication network (WCN) 4 in order to identify who is in charge for payment of bills sent by portable terminal 1.... In today's mobile telecommunication systems the user identity, included in his/her SIM card, is checked out and confirmed by network 4 every time his/her portable terminal 1 is turned on and attached to the telephone network 4. ").

Thus, the preceding quotes from Vazvan do not support the Examiner's reason ("to provide authenticate the subscriber to the financial network ") for modifying Vazvan by the alleged teaching of Nagy. Applicants assert that the preceding quotes from Vazvan demonstrate that incorporation of the alleged teaching of Nagy into Vazvan would either: (1) replace the role of the wireless communication network for identifying the calling party and thus destroy the primary intent of Vazvan's invention; or (2) add an additional method for identifying the calling party which Vazvan teaches away from and which would add unnecessary expense and complexity to Vazvan's invention.

Therefore, Vazvan does not disclose the preceding feature of claim 1.

Based on the preceding arguments, Applicants respectfully maintain that claim 1 is not unpatentable over Vazvan in view of Nagy, and that claim 1 is in condition for allowance. Since claims 2-3 from claim 1, Applicants contend that claims 2-3 are likewise in condition for allowance.

Claim 5

Since claim 5 depend from claim 1, which Applicants have argued *supra* to not be unpatentable over Vazvan in view of Nagy under 35 U.S.C. §103(a), Applicants maintain that claim 5 is likewise not unpatentable over Vazvan in view of Nagy under 35 U.S.C. §103(a).

In addition with respect to claim 5, Vazvan in view of Nagy does not disclose the feature: "wherein the step of sending from the transaction server the user information to the retailer POS

further comprises a step of encrypting the data at the transaction server before sending it and at the retailer pos decrypting the data received”.

The Examiner argues: “Vazvan discloses ... encrypting the data and decrypting data (page 3, lines 33-38; user identify transmitted from the portable terminal to the network is completely encrypted and secured)”.

In response, Applicants assert that the preceding argument by the Examiner has not submitted any evidence allegedly demonstrating that the retailer pos (i.e., the restaurant in Vazvan, FIG. 1) decrypts “the data at the transaction server”. In fact, Vazvan does not disclose decryption by any entity for any purpose.

Therefore, the Examiner has not established a *prima facie* case of obviousness in relation to claim 5.

Claim 6

Since claim 6 depend from claim 1, which Applicants have argued *supra* to not be unpatentable over Vazvan in view of Nagy under 35 U.S.C. §103(a), Applicants maintain that claim 6 is likewise not unpatentable over Vazvan in view of Nagy under 35 U.S.C. §103(a).

In addition with respect to claim 6, Vazvan in view of Nagy does not disclose the feature: “wherein the step of sending at the retailer POS the payment information with the user information to the transaction server a step of encrypting the data at the retailer POS before sending it and at the transaction server decrypting the data received”.

The Examiner argues: "Vazvan discloses ... encrypting the data and decrypting data (page 3, lines 33-38; user identify transmitted from the portable terminal to the network is completely encrypted and secured)".

In response, Applicants assert that the preceding argument by the Examiner has not submitted any evidence allegedly demonstrating that the transaction server (i.e., the computing station 2 in the bang 3 in Vazvan, FIG. 1) decrypts "the data at the retailer POS". In fact, Vazvan does not disclose decryption by any entity for any purpose.

Therefore, the Examiner has not established a *prima facie* case of obviousness in relation to claim 6.

35 U.S.C. § 103(a):Claim 4

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over World Publication No. WO 96/13814 to Vazvan and U.S. Patent Application Publication No. 2003/0119478 to Nagy et al. as applied to claim 1 above, and further in view of U.S. Patent Application Publication No. 2003/0187795 to Lee et al.

Since claim 4 depend from claim 1, which Applicants have argued *supra* to not be unpatentable over Vazvan in view of Nagy under 35 U.S.C. §103(a), Applicants maintain that claim 4 is likewise not unpatentable over Vazvan in view of Nagy, and further in view of Lee under 35 U.S.C. §103(a).

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457 (IBM).

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